

Remarks

Claims 1-38 were pending in the subject application. By this Amendment, claim 25 has been amended, claims 1-24 and 30-38 have been cancelled, and new claims 39-50 have been added. The undersigned avers that no new matter is introduced by this amendment. Entry and consideration of the amendments presented herein is respectfully requested. Accordingly, claims 25-29 and 39-50 are currently before the Examiner for consideration. Favorable consideration of the pending claims is respectfully requested.

By this Amendment, claims 39-50 have been added. Support for new claims 39-50 can be found, for example, at page 2, paragraph 0005, page 3, paragraph 0014, pages 10-11, paragraphs 0043 and 0044, page 12, paragraph 0048, page 14, paragraph 0055, and pages 17-18, paragraphs 0069 to 0072, of the subject specification.

The Examiner has indicated that the title of the invention is not descriptive and that a new title is required that is clearly indicative of the invention to which the elected claims are directed. The applicant has amended the title of the invention to "Methods for Identifying Pesticidal Compounds" which more clearly describes the invention of the elected claims. Accordingly, reconsideration and withdrawal of this objection is respectfully requested.

Claims 25-29 have been rejected under 35 U.S.C. §101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility. The applicant respectfully traverses these grounds for rejection.

The Office Action states that no specific and substantial utility can be established for the polypeptide of SEQ ID NO:2. The applicant respectfully submits that the Patent Office has not established a *prima facie* showing that the claimed invention lacks utility. The Patent Office has not provided sufficient evidence showing that one of ordinary skill in the art would doubt the asserted utility of the subject application to properly shift the burden to the applicant to provide rebuttal evidence sufficient to convince such a person of the invention's asserted utility (*In re Gaubert*, 524 F2d 1222, 187 USPQ 664 (CCPA 1975); *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995) (citing *In re Bundy*, 642 F2d 430, 209 USPQ 48 (CCPA 1981))). However, submitted herewith is a copy of the Declaration under 37 CFR §1.132 by Dr. Dov Borovsky, which was submitted to the

Patent Office in response to the Office Action mailed October 2, 2001 in the parent application, serial no 09/201,568. As outlined by Dr. Borovsky within the Declaration, the nucleotide sequence of SEQ ID NO:1 was isolated using a degenerate primer, which Dr. Borovsky developed from the TMOF complementary peptide (FOMT). Specifically, the degenerate primer was used in a 3' Rapid Amplification of cDNA Ends (RACE) procedure to obtain the 378 base pair cDNA (set forth as SEQ ID NO. 1) from a cDNA library of the mosquito, *Aedes aegypti*. As indicated by Dr. Borovsky in the Declaration, given the well-known experimental methods utilized to isolate the nucleotide sequence set forth in SEQ ID NO. 1, there is no reason to doubt that the corresponding amino acid sequence set forth as SEQ ID NO. 2 exhibits the binding properties of the TMOF receptor. Accordingly, reconsideration and withdrawal of the rejection under 35 USC §101 is respectfully requested.

Claims 25-29 are rejected under 35 U.S.C. §112, first paragraph, as non-enabled by the subject specification. The Office Action indicates that this rejection is based upon the asserted lack of utility, as set forth in the rejection under 35 USC §101. The applicant respectfully traverses these grounds for rejection and hereby incorporates by reference the comments stated above in regard to the rejection under 35 USC §101. The applicant has set forth a credible or well established utility that would be recognized by one of ordinary skill in the art. Furthermore, the applicant submits that, given the disclosure of the subject application, one of ordinary skill in the art would be able to make and use the invention using methods well known in the art. The attached Declaration by the inventor, Dr. Borovsky, also explains the methods used to isolate the cDNA sequence from a genomic library of the mosquito and provides further evidence of the utility and enablement of the subject invention.

As the examiner is aware, "it has been consistently held that the first paragraph of 35 USC §112 requires nothing more than objective enablement...In satisfying the enablement requirement, an application need not teach, and preferably omits, that which is well-known in the art...the law does not require a specification to be a blueprint in order to satisfy the requirement for enablement under 35 USC §112, first paragraph" (*Staehelin v. Secher*, 24 USPQ 2d 1513, 1516 (BPAI 1992)) (emphasis added).

In view of the applicant's remarks above, reconsideration and withdrawal of the rejection under 35 USC §112, first paragraph, is respectfully requested.

Claims 25-28 are rejected under 35 U.S.C. §112, first paragraph, as lacking sufficient written description. The applicant respectfully traverses these grounds for rejection because the subject specification conveys to a person skilled in the art that the applicant was in possession of the claimed invention at the time the application was filed. The applicant is not teaching new methods of genetic manipulation, nor is the applicant teaching the need to discover new genes. Rather, the applicant is teaching the application of known techniques to a previously unknown nucleotide sequence, which is disclosed in the subject specification. All the essential information is provided by the applicant within the subject application to identify homologous TMOF receptors in other organisms.

In view of the above remarks, the applicant respectfully submits that the methods of the invention are adequately described by the specification as filed and, therefore, reconsideration and withdrawal of the rejection as set forth under USC §112, first paragraph, is respectfully requested.

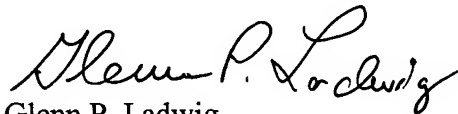
Claims 25-29 are rejected under 35 U.S.C. §112, second paragraph, as indefinite. The applicant respectfully submits that the metes and bounds of the method as currently claimed are clear to those of ordinary skill in the art. However, the applicant has amended claim 25 in order to expedite prosecution of the subject application. Specifically, claim 25 has been amended to replace “TMOF” with “trypsin modulating oostatic factor (TMOF)” and to recite that the method further comprises contacting the compound to the receptor. Support for this amendment can be found, for example, at page 2, paragraph 0005, page 3, paragraph 0014, and pages 10-11, paragraphs 43 and 44, of the subject specification. Reconsideration and withdrawal of the rejection under 35 U.S.C. §112, second paragraph, is respectfully requested.

In view of the foregoing remarks and amendments to the claims, the applicant believes that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 or 1.17 as required by this paper to Deposit Account 19-0065.

The applicant invites the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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Attachments: Petition and Fee for Extension of Time

Copy of Declaration of Dr. Borovsky under 37 CFR §1.132

Exhibit A: *Bost et al.* (1985), *Bost et al.* (1989), and *Rapley et al.* (1998)